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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,276	08/22/2001	David L. Morris	13724 853	1933
7590 06/15/2005			EXAMINER	
PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			ROLLINS, ROSILAND STACIE	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,276

Applicant(s)

MORRIS ET AL.

Examiner

Rosiland S. Rollins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-19 is/are allowed.
- 6) ☒ Claim(s) 1-9 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7/15/04
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

The supplemental reply filed on 5/26/05 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). The amendment does not put the case in condition for allowance. During the interview on May 12, 2005, Mr. Dehlinger discussed the Cosman et al. reference and stated that Cosman et al. does not teach or suggest a tissue-conforming surface capable of conforming to a contour of the tissue. Examiner did agree with Mr. Dehlinger that Cosman et al. did not teach that particular limitation. Upon further review of the application Examiner has found that Behl et al. discloses a tissue-conforming surface, which is been discussed in the 35 USC 103 rejection below. Examiner has also found that Utely et al. (US 6277116) which, was cited by the Applicant in the IDS filed 7/15/04, also discloses a tissue-conforming surface on a related device. Therefore, the amendment does not place the case in condition for allowance and will not be entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Cosman et al. '922. Cosman et al. disclose a method of controlling an ablation volume depth comprising providing a tissue surface treatment apparatus including a housing (137)

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having a tissue contacting surface (figure 10), an advancement device (140); positioning the tissue contact surface; advancing at least one electrode; delivering ablative energy; creating an ablation volume and minimizing injury.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman et al. further in view of Behl et al. Cosman et al. teach all of the limitations of the claims except conforming the contact surface and immobilizing tissue. Behl et al. disclose a similar method and apparatus for its practice. Behl et al. teach that it is old and well known in the art to provide a conforming contact surface thereby immobilizing tissue (col. 3 lines 31-41) to provide a uniform compressive force against tissue and inhibit blood flow to prevent energy losses. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to conform the contact surface and immobilize tissue to in the Cosman et al. method to prevent energy losses.

Allowable Subject Matter

Claims 10-9 are allowed.

Response to Arguments

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Applicant's arguments filed 3/16/05 have been fully considered but they are not persuasive. Applicant argues that the stereotactic guide block of Cosman et al. cannot be relied upon for a teaching of an advancement member, much less an advancement member configured to selectively advance individual electrodes. It is the Examiner's position that the stereotactic technique does not involve manual insertion and by disclosing the use of this technique Cosman et al. inherently teach an advancement device element see US Patent Number 6575969 (col. 23 lines 31-61) for more information regarding the technique. Therefore, a general assessment that all stereotactic techniques involve manual insertion is not accurate.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosiland S Rollins
Primary Examiner
Art Unit 3739

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